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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,172	01/17/2002	Yoshiko Kobayashi	2002-0040A	4795

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EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,172

Applicant(s)

KOBAYASHI ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4. 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al (US 6,428,856) in view of Babler (US 5,648,408) with Ohtomo et al (US 5,475,049), Chase (US 3,102,856) and Ashton et al (US 3,684,197) to show inherent properties of talc.

As to claims 1, 6, 7, Masuda et al disclose a process for forming a multi-layer coating film by applying, to a substrate, intermediate paint, metallic paint and clear paint (See column 9, lines 49-54) by three-coat one-bake (3C1B) method (See column 10, lines 37-41), which process is characterized in that said intermediate paint contains color pigments in an amount 314 parts per 360 parts of resin (87 phr) and extender pigments such as talc (See column 6, lines 20-21) thereby forming coated automotive body (See column 1, lines 4-7). The coating may be applied to a steel substrate, which has been coated with cationic electrodeposition under coating (See column 15, lines 46-55).

Masuda et al fail to teach that the talc extender is of flat shape having size of 0.5 to 10 microns in longer direction (Claims 1, 2) and 0.01 to 1 microns in thickness (Claims 1, 3), and the intermediate paint contains flat talc in an amount 0.5-5 phr (Claims 1, 4) so that total pigment content is 87.5-92 phr (87 phr of the color pigment and 0.5-5 phr talc) (Claims 1, 5).

Babler teaches a process of preparing an easily dispersible stir-in color pigment with improved properties for the use in an automotive coating paint (See column 5, lines 16-17) by

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wet-milling the color pigment and incorporating into the color pigment various additives such as texture-improving agents, anti-flocculating agents or extenders before, during or after the wet-milling of the color pigment (See column 3, lines 38-42) in an amount of from 0.05 to 30 percent, most preferably 5 to 25 percent, by weight, based on the combined weights of the color pigment and the additives (i.e. in an amount from 0.05 phr to 43 phr) (See column 3, lines 42-48). Extenders are, for example, talc or mica, preferably having an average particle size of below 15 microns, preferably 2-10 microns (See column 4, lines 1-9).

Babler is silent about talc being flat shaped with a thickness within a range of 0.01 to 1 microns. However, it is well known in the art that talc has *intrinsically plate-like* (flake-like) structure, as evidenced by Ohmoto et al (See column 4, lines 36-37) because talc is a mineral containing at least 50-80 % of platy talc, as evidenced by Chase (See column 1, lines 62-68; column 3, lines 56-58). It is also well known in the art that any platy talc has thickness of not more than 1/6 of length, as evidenced by Ashton et al (See column 3, lines 1-9). Therefore, talc of Babler having an average particle size of below 15 microns, preferably 2-10 microns, inherently has at least 50% of platy talc, said platy talc having inherently thickness of less than 1/6 of length, i.e., below 2.5 microns, preferably 0.3-1.7 microns.

It is the Examiner's position that 0.05 phr to 43 phr of 2-3 additives (one of which is talc, which inherently comprises at least 50% of flat talc) in Babler covers the claimed flat talc range of 0.5-5 phr.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a color pigment (having added thereto an extender talc) for coloring an intermediate paint in Masuda et al using a process of Babler comprising wet-milling the color

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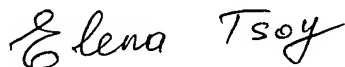
pigment and incorporating from 0.05 phr to 43 phr of 2-3 additives, one of which is a talc extender, which inherently comprises at least 50% of flat talc (the talc extender having an average particle size of below 15 microns), with the expectation of providing the desired easily dispersible stir-in color pigment with improved properties, as taught by Babler.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy
Examiner
Art Unit 1762

April 4, 2003